

#17
3/13/02
C. Stiles

PATENT

Docket No.: 44033-080

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

J. Peter KLEIN, et al.

Application No.: 09/288,556

Filed: April 09, 1999

Group Art Unit: 1624

Examiner: R. Raymond

For: THERAPEUTIC COMPOUNDS FOR INHIBITING INTERLEUKIN-12 SIGNALING
AND METHODS FOR USING SAME

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This is in response to the Office Action of August 7, 2001 wherein an election of species has been required. The present application is a Continued Prosecution Application (CPA) under 37 CFR § 1.53(d) based on parent Application No. 09/288,556. In the parent application, an election of species requirement was made in Paper No. 5, in which Examiner Oriares stated that "Claims 1 and 11 are generic to a plurality of disclosed patentably distinct species comprising triazoles, diazoles, thiazoles thiadiazoles". In response, Applicants elected compounds of Formula I in claim 1 wherein x and y are "N" and z is "C", for initial prosecution on the merits. Examiner Oriares withdrew claims 2-20 from consideration as a result of the election.

Prosecution was conducted through a final rejection on the elected species (Paper No. 11). In an amendment under 37 CFR § 1.116, Applicants amended claim 1 and added new claim

Application No. 09/288,556

21 directed to specific compounds to the single elected species. In an Advisory Action (Paper No. 13), the amendment was denied entry because the amendment allegedly presented additional claims without canceling a corresponding number of finally rejected claims. The Advisory Action did not assert that the claims were drawn to a non-elected species. In response to the Advisory Action, Applicants filed a request for a CPA and requested entry of the unentered amendment under 37 CFR § 1.116. In response, the outstanding August 7 Office Action was issued by Examiner Raymond, which asserts a new election of species requirement.

Applicants respectfully submit that the outstanding restriction requirement is not understood. The Examiner states that "Claims 1, 8 and 9 are generic to a plurality of disclosed patentably distinct species comprising the compounds of the working examples" and that Applicants are required to elect a single disclosed species. It is Applicants' understanding under CPA practice, claims 2-20 continue to be withdrawn from consideration and that claim 1 as amended by the amendment under 37 CFR § 1.116 and new claim 21 presently before the Examiner for examination. Because Applicants have already elected compounds of Formula I in claim 1 wherein x and y are "N" and z is "C", for prosecution on the merits, it is appropriate to continue with that election.

Accordingly, Applicants reiterate their election of the compounds of Formula I in claim 1 wherein x and y are "N" and z is "C" and the compounds defined in claim 21, for purposes of complying with the Examiner's requirement. It is respectfully requested that claim 1 as amended and claim 21, which are believed to be drawn to the elected species, be considered for examination on the merits. If the Examiner believes that this paper is not responsive to the

Application No. 09/288,556

election of species requirement, then he is invited to contact the undersigned attorney to provide clarification of the outstanding issues.

To the extent necessary, a petition for an extension of time under 37 CFR 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT, WILL & EMERY



Cameron K. Weiffenbach
Registration No. 44,488

Willem F. Gadiano
Registration No. 37,136

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 CKW:MWE
Date: September 6, 2001
Facsimile: (202) 756-8087